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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

87239/4

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on \_\_\_\_\_

Signature.....

Typed or printed name \_\_\_\_\_

Application Number

10/774,877

Filed

February 10, 2004

First Named Inventor

SIMPSON, Todd

Art Unit

2452

Examiner

CHANKONG, DOHM

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.



Signature

assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

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October 1, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below.

\*Total of \_\_\_\_\_ forms are submitted.

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**REMARKS**

Applicant requests this review because Applicant believes that the claim rejections are clearly improper and without any factual basis. The Examiner:

- failed to consider the language in the claims
- substituted his own language for the claims
- responded to arguments never advanced by Applicant and rejected them

Consequently, neither the Final Office Action nor the Advisory Action establishes a *prima facie* case of obviousness sufficient to support a rejection under 35 U.S.C. §103(a).

Applicant respectfully submits that the Examiner failed to make the required factual findings of all claim elements in the cited prior art references to establish a *prima facie* rejection. For example, claim 14 recites a system that includes a sender subsystem and a receiver subsystem, wherein the receiver subsystem is configured to permit the sender subsystem to add a new category to the listing of receiver categories. Schiavone does not teach this. The Examiner alleged that Gross taught this feature and cited paragraph [00263] in Gross to support this position. According to the Examiner,

“wherein the receiver subsystem is configured to permit the sender subsystem to add a new category to a listing of receiver categories [See Response to Arguments, section C, above | Gross, Fig. 1: sender and receiver using a personal computer and system where the personal computer/system read on Applicant’s claimed subsystem | 0263: sender making suggestions through his computer to the receiver]” (page 5, Final Office Action),

and further,

“it is clear from Gross that while a human operator adds the category, he does so using the subsystem. In other words, the subsystem carries out the operator’s command.” (Response to Arguments, section C on page 3, Final Office Action).

By replacing “sender subsystem” and “receiver subsystem” with “a personal computer and system” or “Applicant’s claimed subsystem”, the Examiner failed to consider the language of the claims before him. The subject matter considered by the Examiner is changed from:

the receiver subsystem is configured to permit the sender subsystem to add a category  
to  
a receiver can use his computer to add a category.

Consequently, the claims considered by the Examiner are not the claims of Applicant. Applicant first noted this difference in a response filed on June 9, 2009 in response to the Office Action of March 9, 2009. In that response, Applicant explained on pages 15 and 16:

Gross only discloses that a "sender" may suggest a new category, which the receiver may accept or reject. However, "sender" as used by Gross here is a user ("User 1", see [0261], Gross), i.e., a human operator, not a sender subsystem as required by Applicant's claims. Similarly, "recipient" of Gross also refers to a user ("User 2", see [0261], Gross), another human operator. The acceptance or rejection of the sender's suggestion must be confirmed by the receiver. Applicant has studied carefully the entire disclosure of Gross and is unable to locate any teaching in Gross of a receiver subsystem that permits new categories to be added by a sender subsystem. The Examiner also was not able to identify any other passages in Gross disclosing such a receiver or sender subsystem as required by Applicant's claims.

After Applicant urged the Examiner to examine the actual claims submitted for examination in two telephone interviews and two responses filed replying to two other final office actions issued subsequent to the response filed on June 9, 2009, the Examiner in this Final Office Action, mailed on June 3, 2010, still failed to make a distinction between "receiver subsystem" and "subsystem" and "sender subsystem" and "subsystem", as noted above.

During the telephone interview of July 7, 2010, this failure was discussed again and brought to the Examiner's attention. After explaining the differences between a "sender subsystem" and a "receiver subsystem" and their significance in the claims, the Examiner agreed to consult Gross again and evaluate Applicant's claims taking into account these words in the claims and the supporting arguments. However, in the Advisory Action mailed on August 18, 2010, the Examiner still failed to consider the word "receiver" in "receiver subsystem" and "sender" in "sender subsystem" while maintaining the rejections. The citation to Gross still relies on teaching of a "subsystem" (or "a PC") in Gross, without differentiating whether it was a "receiver subsystem" or a "sender subsystem" that is "configured to permit" whether a "sender subsystem" or a "receiver subsystem" "to add a new category" (see, e.g., page 2, line 32, Advisory Action: "Gross teaches a user using a PC to add a category to a receiver's listings"; emphasis added). Removing these words from the claims would alter the subject matter of the claims. For example, removing "sender" from "sender subsystem" and then applying teachings related to a "receiver subsystem" (a receiver user using a receiver's PC to add a receiver's

category) would not serve to advance the prosecution of the application. Any rejections of the claims based on altered claims cannot be proper and must be withdrawn.

For easy reference, paragraph [0263] from Gross is reproduced again in its entirety:

It will be appreciated that new processing criteria can be continuously added, deleted, or changed by a recipient or a 3<sup>rd</sup> party, such as an administrator, on behalf of the recipient. It will also be appreciated that a sender can make suggestions to a receiver--by, for example, means of a message--to add processing criteria not yet known to the receiver, which the receiver can confirm to accept or reject. (Emphasis added)

As Applicant explained in Response on page 11, starting at line 11, "there is no teaching, at least in this cited paragraph, that the receiver subsystem is configured in a particular way as required by Applicant's claims. i.e., to permit the sender subsystem to add a new category. There is simply no such disclosure, as can be seen in paragraph [0263] quoted above."

Therefore, by combining the teachings in Schiavone and Gross, one is still left without a method or system for categorizing messages, in which "the receiver subsystem is configured to permit the sender subsystem to add a new category to a listing of receiver categories."

Accordingly, it is respectfully submitted that, due to his failure to consider all words in the claims, the Examiner failed to establish a *prima facie* case of obviousness sufficient to support a rejection under 35 U.S.C. §103(a).

In addition, in the Advisory Action, instead of responding to the actual arguments made by Applicant in numerous responses, the Examiner seemed to have responded to an argument never advanced by Applicant. For example, in the Advisory Action, while first acknowledging that the Applicant's arguments "center on the limitation which recites 'the receiver subsystem is configured to permit the sender subsystem to add a new category to a listing of receiver categories'", the Examiner continued with the following: "Applicant argues that the limitation clearly should only be interpreted as a subsystem acting independently of any user" (page 2, line 25, Advisory Action) and then rejected this argument.

Applicant never made this argument. Applicant never argued that the claim limitation should be interpreted as a subsystem acting independently of any user.

In fact, during the telephone interview, when the Examiner suggested Applicant to consider amending the claims to add "independent of any user", Applicant's representatives explained that Applicant's claims only require that the receiver subsystem to be configured to permit the sender subsystem to add a new receiver category and that this is not taught in any cited references. Therefore Applicant considers any such amendment unnecessary.

Thus, Applicant did not amend the claims to add "independent of any user". Applicant also did not argue that claim limitations should be interpreted this way. Applicant only advanced the argument that Gross did not teach a receiver subsystem configured in a manner as required by Applicant's claims.

For example, as noted above, Applicant stated first in Response that "Claims 14, 24, 37, 47 and 52, as amended in a claim amendment submitted on June 9, 2009, all require that the receiver subsystem is configured to permit the sender subsystem to add a new category to a listing of receiver categories." (See bottom of page 9, Response) Applicant then reiterated his position that "the combined teachings in Schiavone and Gross does not in fact teach a system or method that meets all claim limitations as recited in these independent claims, despite the Examiner's assertions." (First paragraph on p. 10, Response). After discussing what is actually disclosed in Gross, Applicant concluded that "it is clear that Gross does not in fact, in this paragraph (and elsewhere), disclose any receiver subsystem and sender subsystem, wherein the receiver subsystem is configured to permit the sender subsystem to add a new category to the listing of receiver categories."

There are more such examples. For example, on page 11, starting at line 12, Applicant noted in Response:

there is no teaching, at least in this cited paragraph, that the receiver subsystem is configured in a particular way as required by Applicant's claims, i.e., to permit the sender subsystem to add a new category. There is simply no such disclosure, as can be seen in paragraph [0263] quoted above.

At page 12, starting at line 22, Applicant explained in Response why there is no such teaching as alleged by the Examiner:

Gross describes a scenario that always requires the action of the receiver; whereas according to Applicant's claims, adding a new category by the sender subsystem is always permitted by the receiver subsystem (the receiver subsystem is configured to

permit the sender subsystem to add a new category to the listing of receiver categories). Gross describes that the recipient does not permit the sender to add anything; it does not describe a receiver subsystem that is configured to permit the sender subsystem to add a new category. (emphasis added)

Yet again, on page 14, starting at line 4, Applicant further explained in Response that:

The Examiner attempted to combine the teaching of Schiavone with that of Gross to produce the claimed subject matter. However, Gross teaches that it is for the receiver to accept or reject any suggestion from the sender, whereas Applicant's claims require that the sender and receiver subsystems are such that the sender subsystem is always permitted to add a new category. The receiver subsystem is already configured to permit the sender subsystem to perform this act. It is clear that Gross emphasizes on control by the receiver ("Upon receipt of a tagged message, the message is processed in accordance with processes identified by the tags. The recipient maintains control of the processing of the messages," para. [0044]. Gross). This is the opposite of how Applicant's claimed system functions. Modifying Gross' system to give control to the sender subsystem would be against the objective of Gross' invention. Accordingly, the combination of teaching of Schiavone with that of Gross suggested by the Examiner is not proper.

Thus, the actual argument advanced by Applicant was that "Gross describes that the recipient does not permit the sender to add anything; it does not describe a receiver subsystem that is configured to permit the sender subsystem to add a new category" (page 12, lines 26-28, Response). Applicant did not argue at all that "the claim limitation should be interpreted as a subsystem acting independently of any user" as the Examiner stated, which is also an argument purportedly rejected by the Examiner.

It is respectfully submitted that it is improper to reject the application on the ground that an argument never advanced by Applicant would not be persuasive! Rejections must be made on the basis of actual claim language before the Examiner and arguments presented by Applicant. This is not the case here.

It is believed that a proper review of the present application in light of the comments provided herein will allow a proper evaluation of the claims being presented for examination, the argument actually advanced by Applicant to distinguish the prior art and a proper evaluation of the art, and would afford the Examiner the opportunity to clarify with the Applicant's representative any outstanding issues.